

RESPONSE AND REMARKS

This is in response to the Office Action regarding the above-identified application dated April 21, 2005, which was designated a final rejection.

Amendments to Claims 7, 10-14, 23-24, and 26 are filed concurrently herewith to more distinctly claim the claimed invention. Original Claims 1-6, 8, 9, and 15-22 were previously withdrawn without prejudice. Entry of the amendments, and reconsideration of the application, as amended, are respectfully requested in view of the following remarks.

CLAIM OBJECTIONS UNDER 35 U.S.C. § 132 (a)

In the Final Office Action, the Examiner objected to earlier-filed amendments under 35 U.S.C. § 132 (a) as introducing new matter not supported by the original specification. Specifically, the Examiner objected to the limitation:

...the first user is designated in a memory accessible by the computer system as restricted from finalizing shipping labels.

In the Final Office Action, the Examiner stated that "the specification talks about users being able to finalize shipping labels, but not specifically disclose the system designating users as being 'restricted from finalizing the shipping labels', and the phrase 'partial shipment information' does not appear in the specification...". In the Final Office Action, the Examiner concluded that the specification does not support the objected to limitations and stated that "[a]pplicant is required to cancel the new matter in reply to this Office Action." In the Final Office Action, the Examiner did not identify the specific Claims objected to under Section 132(a) but later rejected Claims 7, 11, 13 and 14 under 35 U.S.C. § 112, first paragraph, on similar grounds "as failing to comply with the written description requirement."

The Examiner's objections have been carefully considered. It is respectfully submitted, for the reasons given below, that the previously-filed amendments did not add any new matter and that the "restricted from finalizing shipping labels" limitation and the "partial shipment information" limitation are

both fully supported by the specification as required under the first paragraph of 35 U.S.C. § 112 and do not introduce new matter as prohibited under 35 U.S.C. § 132 (a).

The "Restricted From Finalizing Shipping Labels" Limitation

It is respectfully submitted that the only claim in which the specific objected-to "restricted from finalizing shipping labels" limitation appears, is Claim 7. However, Claim 10 (as it was originally filed and also as it was previously amended) provided a similar limitation. As originally filed, Claim 10 recited: "... designate a particular user within an enterprise as restricted from printing shipping labels according to instructions input by an administrator of the enterprise." As previously amended, Claim 10 recited: "designate in a memory accessible by the computer system, a first shipping privilege setting identifying a first user within the enterprise as restricted from printing shipping labels but authorized to submit pre-processing shipping requests ...".

First, because the recitation "... designate a particular user within an enterprise as restricted from printing shipping labels according to instructions input by an administrator of the enterprise" was provided by an original claim, namely Claim 10, that recitation was part of the specification, and therefore satisfies the written description requirement under section 112. See Union Oil Co. of California v. Atlantic Richfield Co., 208 F.3d 989, 998, n.4, (Fed. Cir. 2000), *cert. denied*, 121 S. Ct. 1167 (2001) ("One of this court's predecessor courts clarified that disclosure in an originally filed claim satisfies the written description requirement. See In re Gardner, 480 F.2d 879, 880 (CCPA 1973) ("Under these circumstances, we consider the original claim in itself adequate 'written description' of the claimed invention. It was equally a 'written description' whether located among the original claims or in the descriptive part of the specification.")).

It is respectfully submitted that the recitation "... designate a particular user within an enterprise as *restricted from printing shipping labels* according to instructions input by an administrator of the enterprise", provided by an original

claim, namely Claim 10, is support by the specification as required under the first paragraph of 35 U.S.C. § 112 for one form of "restricted from finalizing shipping labels" in that printing a shipping label is one form of finalizing a shipping label.

It is therefore respectfully submitted that, because the recitation "... designate a particular user within an enterprise as restricted from printing shipping labels according to instructions input by an administrator of the enterprise" was provided by an original claim, and because that original claim language supports the objected-to limitation, the claims as amended do not introduce new matter.

Further, it is respectfully submitted that that the below-cited references to the specification, for example, when read together, support the objected-to "restricted from finalizing shipping labels" limitation:

1.) "Administrator-established privileges [on a System database 52 (see, e.g., Published Application (US 2002/0032573 A1), Specification, paragraphs 0116 -0118)] for each particular User controls the functionality available to the particular User.... The System provides the administrator the ability to assign User privileges such as: ... Ability to print shipping labels vs. traveler labels, by Carrier or by service..." (Published Application (US 2002/0032573 A1), Specification, paragraphs 0130 - 0134);

2.) "For shipping circumstances in which a User is not allowed to print an actual shipping label, Users can print "traveler" labels, which help identify pre-processed packages for mailroom personnel to complete." (Published Application (US 2002/0032573 A1), Specification, paragraph 0413);

3.) "In one exemplary embodiment of the invention, the Desktop User is either not authorized by the Administrator to print Shipping Labels, or is limited by the Administrator to printing Shipping Labels for only certain types of packages, e.g., Letters. In such an embodiment, the Administrator enables a Shipping Station for the Desktop User. In some cases, a particular Desktop User may decide to not finalize shipping and delegate the actual shipping to some other user within the Enterprise. For example, if the Desktop User is not certain of the weight of a package, the Desktop User, even if that user has shipping lab[el] printing privileges, may decide to print a traveler label, attach the traveler label to the package, and forward the package to a Shipping Station User to complete

shipping." (Published Application (US 2002/0032573 A1), Specification, paragraph 0447).

4.) Referring to FIG. 55, the specification explains that "[t]he User enters package and shipping information 335 which is stored in the System databases 336. The User requests printing of a traveler label, which the System prints on a printer local to the User 340. The User delivers the package together with the traveler label to the Shipping Station. The Shipping Station then scans in the Traveler Label 341 in order to retrieve the package and shipping information from the System's databases 342-344 to populate the shipping information necessary to rate the shipment and finalize the shipping process and complete a shipping label 345-351. This application is used, for example, where Desktop Users have no way of weighing each package." (Published Application (US 2002/0032573 A1), Specification, paragraph 0448);

5.) Referring to FIG. 56 (which depicts an exemplary traveler label), the specification further explains that "[a]s was described above in relation to 345-351 depicted in FIG. 55, the System uses the retrieved package and shipping information, e.g., 363 and 364, to populate the shipping information necessary to rate the shipment and finalize the shipping process and complete a shipping label." (Published Application (US 2002/0032573 A1), Specification, paragraph 0449).

It is respectfully submitted that, e.g., the citation to the Specification in 3.) above that " the Desktop User is either not authorized by the Administrator to print Shipping Labels ..." supports the objected-to "restricted from finalizing shipping labels" limitation in that printing shipping labels is one form of finalizing shipping labels. Further, it is respectfully submitted that, e.g., the citation to the Specification in 4.) above that after "[t]he User requests printing of a traveler label ...", "[t]he Shipping Station then scans in the Traveler Label ... in order to retrieve the package and shipping information from the System's databases ... to populate the shipping information necessary to rate the shipment and finalize the shipping process and complete a shipping label ..." supports the objected-to "restricted from finalizing shipping labels" limitation in that the user described as requesting printing of a Traveler Label did not finalize the corresponding shipping label; the corresponding shipping label was finalized via the described Shipping Station.

It is respectfully submitted that, because the above-cited references, read together, fully support the objected-to "restricted from finalizing shipping labels" limitation, the claims as previously amended, and as currently amended, do not introduce new matter.

The "Partial Shipment Information" Limitation

It is noted that Claims 7, and 11-14 contain the objected-to "partial shipment information" limitation.

Although the specific term "partial shipment information" is not expressly recited in the specification, it is respectfully submitted that the below-cited references to the specification, for example, when read together, fully support the "partial shipment information" limitation:

1.) "As will be described in more detail below, a "traveler" label is not an actual shipping label. Rather, a traveler label is a pre-processing label that the User chooses to print and then provides with the package to an Enterprise Shipper; the receiving Enterprise Shipper uses the traveler label to complete the processing necessary to print a shipping label." (Published Application (US 2002/0032573 A1), Specification, paragraph 0125);

2.) "The administrator can define the traveler label format to be used. The traveler label includes a bar code that, when scanned, enables quick retrieval of the shipment record from the System by mailroom personnel using the Ship Station client." (Published Application (US 2002/0032573 A1), Specification, paragraph 0414);

3.) Referring to FIG. 55, the specification explains that "[t]he User enters package and shipping information 335 which is stored in the System databases 336. The User requests printing of a traveler label, which the System prints on a printer local to the User 340. The User delivers the package together with the traveler label to the Shipping Station. The Shipping Station then scans in the Traveler Label 341 in order to retrieve the package and shipping information from the System's databases 342-344 to populate the shipping information necessary to rate the shipment and finalize the shipping process and complete a shipping label 345-351. This application is used, for example, where Desktop Users have no way of weighing each package." (Published Application (US 2002/0032573 A1), Specification, paragraph 0448);

4.) FIG. 56 is a graphic representation depicting an exemplary Traveler Label in an exemplary embodiment of the invention. As depicted in FIG. 56, a Traveler Label reports Shipping Addresses 363, Package Information Details 364, and an instruction to take the package to the appropriate shipping counter 361. Further, the Traveler Label provides a System Tracking Number 362 and a bar code label 360. When the User delivers the package together with the traveler label as depicted in FIG. 56 to the appropriate Shipping Station, personnel at the Shipping Station scans the bar code 360 in the Traveler Label in order to retrieve the package and shipping information, e.g. 363 and 364, from the System's databases. (Published Application (US 2002/0032573 A1), Specification, paragraph 0449).

5.) Referring to FIG. 56 (which depicts an exemplary traveler label), the specification further explains that "[a]s was described above in relation to 345-351 depicted in FIG. 55, the System uses the retrieved package and shipping information, e.g., 363 and 364, to populate the shipping information necessary to rate the shipment and finalize the shipping process and complete a shipping label." (Published Application (US 2002/0032573 A1), Specification, paragraph 0449).

It is respectfully submitted that, e.g., the action described in the Specification citation in 5.) above to "rate the shipment and finalize the shipping process and complete a shipping label" supports the objected-to "partial shipment information" limitation in that the action to "rate the shipment and finalize the shipping process and complete a shipping label" shows that rating was needed to finalize the shipping process and complete the shipping label; that is, until rating, shipment information is partial.

It is respectfully submitted that, because the above-cited references to the specification, when read together, fully support the objected-to "partial shipment information" limitation, the claims as previously amended, and as currently amended, do not introduce new matter.

CLAIM REJECTIONS UNDER 35 U.S.C. § 112

In the Final Office Action, the Examiner rejected Claims 7, 11, 13 and 14 under 35 U.S.C. § 112, first paragraph, "as failing to comply with the written description requirement." The Examiner referred to the above-outlined

"objection to amendment" as grounds for the Section 112 rejection, saying that "[t]he claims(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention."

For the reasons described above with respect to the objection under Section 132(a), it is respectfully submitted that the specification supports both the objected-to "restricted from finalizing shipping labels" limitation and the objected-to "partial shipment information" limitation, that the previously-filed and currently - filed amendments do not add new matter, and that, therefore, the claims comply with the written description requirement under Section 112, first paragraph.

It is respectfully noted that the Examiner stated no other ground for rejecting Claims 23-26 (which are dependent on Claims in the Claim 7, or 10-14 families) other than the Section 112 and 132(a) grounds.

CLAIM REJECTIONS UNDER 35 U.S.C. § 102(e)

In the Final Office Action, the Examiner rejected Claims 7 and 10-14 as being anticipated by Stefik et al., (US Publication No. 2003/0115144; "Stefik").

In rejecting Claims 7 and 10-14, the Examiner considered "the system of Stefik to be fully capable of generating a printable bar-coded pre-processing traveler label, in response to a ship request due to the fact that this is considered to be intended use." Citing Ex parte Masham, 2 U.S.P.Q.2d 1647 (1987) and In re Paulsen 30 F.3d 1475 (Fed. Cir. 1994), the Examiner stated that "[i]t has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the structural limitations." The Examiner reasoned that Stefik discloses "the computer system assigning rights of access to digital works..." and "is fully capable of designating a first user in a memory accessible by the computer system as restricted from finalizing shipping labels, and wherein the printable bar-coded pre-processing traveler label contains partial shipment information..." The Examiner concluded, on the basis of Ex parte Masham and In

re Paulsen, that "the computer system of Stefik [is] fully capable of delegating finalizing a shipping label for shipping the parcel to a second user within the enterprise, wherein the second user is designated in the memory accessible of the computer system as authorized to finalize shipping labels."

In the Final Office Action, the Examiner rejected Claims 10-14, similarly finding the *Stefik* system "fully capable" of the subject matter of Claims 10-14.

REMARKS REGARDING THE SECTION 102(e) REJECTION

The Examiner's rejections under Section 102(e) have been carefully considered. Claims 7, 10-14, 23-24, and 26 have been amended. For the reasons given below, it is respectfully submitted that *Stefik* does not disclose or suggest, nor do any of the other references of record disclose or suggest, all of the limitations of amended independent Claims 7 and 10, or the claims dependent on them.

Independent Claim 7

Amended independent Claim 7 is directed to an online, Internet-based, multi-carrier, multi-parcel shipping management computer system that is programmed to:

receive a request by a first user within an enterprise to ship a parcel, wherein the first user is designated in a memory accessible by the computer system as restricted from finalizing shipping labels, wherein the request comprises a set of partial shipment information, wherein the printable bar-coded pre-processing traveler label contains the set of partial shipment information, and wherein the set of partial shipment information comprises at least one of: a destination name, a destination address, a return name, a return address, or package information;

in response to the request by the first user to ship the parcel: (A) generate a printable bar-coded pre-processing traveler label, wherein the printable bar-coded pre-processing traveler label comprises at least a machine-readable code, and (B) print the printable bar-coded pre-

processing traveler label, wherein said printed printable bar-coded pre-processing traveler label comprises an expression of the machine-readable code;

receive an input for finalizing a shipping label for shipping the parcel from a second user within the enterprise, wherein the second user is designated in the memory accessible by the computer system as authorized to finalize shipping labels; and

generate a shipping label comprising at least a first item of information from the set of partial shipment information and according to the input from the second user.

It is respectfully asserted that the prior art references cited by the Examiner do not teach or suggest all of the limitations of amended independent Claim 7. One advantage of an online, Internet-based, multi-carrier, multi-parcel shipping management computer system according to various embodiments of the system claimed in amended Claim 7 is that such embodiments allow some users within an enterprise to request a shipment of a package and identify information for shipping the package even if those users do not have all of the information necessary for completion of a shipping label for the package. For example, such users may not have immediate access to a postal scale for weighing a package. Such embodiments allow a second user within the enterprise to complete a shipping label for shipping the package with information available to the second user but that may not have been available to the requesting user.

In view of the above-given reasons that the prior art references cited by the Examiner do not teach or suggest all of the limitations of amended independent Claim 7, it is respectfully asserted that the prior art references cited by the Examiner do not teach or suggest all of the limitations of Claims 23-25, that are, in one way or another, dependent on Claim 7.

Independent Claim 10

Amended independent Claim 10 is directed to an online, Internet-based, multi-carrier, multi-parcel shipping management computer system that is programmed to:

according to a first set of instructions input by an administrator of an enterprise, designate in a memory accessible by the computer system, a first shipping privilege setting identifying each user of a plurality of users within the enterprise as restricted from printing shipping labels but authorized to submit pre-processing shipping requests; and

according to a second set of instructions input by the administrator, designate in the memory, a second shipping privilege setting identifying at least a second user within the enterprise as authorized to print shipping labels according to a pre-processing shipping request by any user of the plurality of users.

One advantage of an online, Internet-based, multi-carrier, multi-parcel shipping management computer system according to various embodiments of the system claimed in amended independent Claim 10 is that such embodiments allow an administrator within an enterprise to designate some users within the enterprise as authorized to request a shipment of a package, but as restricted from printing shipping labels -- for example, users within the enterprise that do not have all of the information, such as, for example, the weight of a package, that would be necessary for completion of a shipping label for a package, could be designated by the administrator as authorized to request a shipment of a package, but as restricted from printing shipping labels. Such embodiments allow the administrator to designate at least a second user within the enterprise, such as, for example, a postal clerk within the enterprise who has access to scales to accurately weigh each package, to complete a shipping label for shipping the package with information available to the second user but that may not have been available to requesting users.

In view of the above-given reasons that the prior art references cited by the Examiner do not teach or suggest all of the limitations of amended

independent Claim 10, it is respectfully asserted that the prior art references cited by the Examiner do not teach or suggest all of the limitations of Claims 11-14, and Claim 26, that are, in one way or another, dependent on Claim 10.

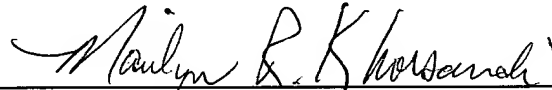
CONCLUSION

In view of the foregoing amendments, and for the foregoing reasons and authorities, it is respectfully submitted that the invention disclosed and claimed in the present amended application is not fairly taught by any of the references of record, taken either alone or in combination, and that the application is in condition for allowance. Accordingly, Applicant respectfully requests reconsideration and allowance of the amended application.

Respectfully submitted,

KHORSANDI PATENT LAW GROUP, ALC

By



Marilyn R. Khorsandi
Reg. No. 45,744
626/796-2856